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EXAMINER

YENKE, BRIAN P

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/718,931  
Filing Date: November 21, 2000  
Appellant(s): ARLING ET AL.

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Gary R. Jardsik  
Reg. No. 35,906  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 27 March 2006 appealing from the Office action mailed 03 March 2006.

***(1) Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

***(2) Related Appeals and Interferences***

A statement identifying that no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

***(3) Status of Claims***

The statement of the status of the claims contained in the brief is correct.

***(4) Status of Amendments***

All amendments have been entered.

***(5) Summary of Invention***

The summary of invention contained in the brief is correct.

***(6) Grounds of Rejection To Be Reviewed On Appeal***

The appellant's statement on the grounds of the rejection in the brief is correct.

***(7) Claims 6-9, 11 and 15-19 (Appendix)***

The copy of the appealed claims contained in the Appendix to the brief is correct.

***(8) Evidence Relied Upon***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal:

	US 5,287,109	02-1994
OFFICIAL NOTICE	JP 10145634	05-1998

***(9) Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8 and 15-18 rejected under 35 U.S.C. 102(b) as being anticipated by Hesse, US 5,287,109.

In considering claims 6, 8 and 15-18,

Hesse discloses a programmable remote control 1 (Fig 1) which may control a plurality of devices whether the user is present or not. The remote includes a real time clock 20 which is used with the programmed time information stored in memory by comparing (via scanner) the time current time and the time desired to implement a user programmed action (col 2, line 52-63) *(meeting the claimed timer for timing a predetermined interval)*. The remote includes an IR transmitter 14 *(meeting the claimed wireless transmitter)* along with memory 12 and memory 18. As shown in Fig 1, the user can operate the remote in either a manual (requires users constant input) or auto, which allows the remote to control the devices as the user instructed which is stored in the memory of the remote. The remote may change channels at user desired times, turn on/off the devices at desired times, as well as recording functions and conventional remote

Art Unit: 2622

features (col 2, line 1-10, col 2, line 34-61, col 3, line 24-29/line 46-60, col 9, line 6-19). The system also allows the user to implement a pause (a delay of a certain period) between functions if desired. Thus in the broadest sense the user can request to record a channel (say channel 5) for today/tomorrow or sometime in the future for 30 minutes, the user can also program the system to record another channel (say channel 6) for the same day immediately preceding the 1<sup>st</sup> recording (of channel 5, with no optional pause delay) and then go back to channel 5 for recording or display, where the remote causes the TV/VCR to return to the primary channel (i.e. channel 5). As stated by Hesse the remote can be programmed by the user as well as download control codes via devices (i.e. actuate as a learning remote) (*meeting the programming stored in memory for performing steps*) Thus the limitations of the above claims are anticipated by the reference, where given the broadest interpretation the first channel choice meets *the first predetermined user action* and the subsequent selection/reservation meets *the second predetermined user action in starting the timer*.

In considering claim 8,

As stated above with respect to claim 6, Hesse discloses a remote control (Fig 1) which includes keys that allow a user to switch channels and/or record programs (in manual or auto mode), where the second predetermined action above includes operating a/the key(s) on the remote.

In considering claim 15 (the only difference between claim 6 and 15 is the response to the first and second user actions are switched (i.e. now first action sets a timer)).

The claimed *setting a timer in the remote control in response to a user first input* and the claimed *storing a primary channel in memory in response to a user second input* is met by the

remote wherein the programming mode (col 9, line 6-40) asks the user to select the time, the device(s), and the functions actuated (i.e. channel selection), wherein the first input would be selecting the time (*which sets the timer*) and selecting the channel (2<sup>nd</sup> input, subsequent action) (*stores the channel (i.e. primary) in memory*), and once the time at which the selected (i.e. primary channel) was desired, the system would return to that reserved channel.

In considering claim 16,

Hesse discloses the user ability to record/reserve/channel switch programs thus the user may provide multiple inputs for recording/reserving/selecting at various times, meeting the claimed 3<sup>rd</sup> input (i.e. 3<sup>rd</sup> selection or reselected/edited 1<sup>st</sup> or 2<sup>nd</sup> selection).

In considering claim 17,

Hesse disclose operating keys on the remote which allow the user to utilize the remote either in manual or auto-mode, wherein the user may operate a key(s) on the remote to input/select an appropriate command(s)/function(s), where the user may make multiple inputs with the desired key(s), meeting the claimed 1<sup>st</sup>/2<sup>nd</sup> input comprises operating a/the key.

In considering claim 18,

Hesse discloses operating the remote wherein the user may select to record/select/activate/switch a program for a longer time (*meeting the claimed duration greater than a duration required to effect one of the user first or second input*).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2622

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse, US 5,287,109 in view of Kuno, JP 10145634.

In considering claims 7, 9, 11 and 19,

Hesse does not explicitly recite the conventional return to channel instructions, where a conventional system upon the activation of a button (manually) will activate a timer and will return back to the original/primary program after a predetermined time (when the commercials are expected to be over), and also allowing the user to return to the primary channel (via the user repeating a predetermined action, i.e. return/primary program etc...) prior to the timed interval, both being well known, thus the examiner takes OFFICIAL NOTICE, regards to such, since if Hess was operating in the manual mode it would be beneficial to the user who started surfing during commercials to return to the original program when the commercials are expected to be finished or before they were (via user repeated action), both which would allow the user to return to the original program when it began/before it already began.

Based upon the appellant's traversal of the above "OFFICIAL NOTICE" the examiner will rely upon Kuno.

Kuno discloses the use of a conventional remote control system where once a scan switch 10 (Fig 1) is depressed the remote will wirelessly transmit a signal to a television timer 2, a primary (current) channel is stored in memory 22, then a remote control output signal (wireless) 5 is sent to the TV receiver 3 to scan the channels and when a prescribed/predetermined time is

exceeded a remote control signal 5 is sent to instruct channel restoration (return to primary channel).

As stated in the rejection, Hesse given the broadest interpretation of the claims discloses a remote control, which provides the user the ability to return to a current/primary channel/program at a user desired time.

The examiner acknowledges that Hesse does not mention commercials nor do the currently pending claims.

However, the examiner has incorporated Kuno to show evidence that by a selection of a button (whether once, twice etc...) a system is known to store the current channel and start a timer so the user can scan other channels and at the end of a period of time automatically return the user to the original (program viewed before scanning) channel. The system in the most basic sense provides the user the ability to scan/surf other channels when a commercial on the currently viewed program appears, allowing the viewer to watch/preview other material without having to view the commercial(s).

Therefore, it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to modify Hesse, which provides the user the ability to operate in either the manual or automatic mode in order to record/reserve/switch channel(s)/program(s), by also allowing the viewer to scan other channels and skip commercials on a currently viewed channel by depressing a button, which would then return the viewer to the original (commercial free) channel as done by Kuno.

Regarding the above limitations, the combination of Hesse/Kuno, meet the limitations wherein the selection of the scan switch 10, stores a channel starts a timer each time the switch is

selected. Thus the user selecting the switch a subsequent time (during a scanning period) before the 1<sup>st</sup> time expiring, resets the timer to a new primary channel (meeting the claimed limitations of 7, 9, 11 and 19 of repeating the first action/second action/same predetermined action/single key).

***(10) Response to Arguments***

***Appellant's Arguments***

a) Appellant states that the remote of Hesse fails to have a timer for timing a predetermined time interval and also fails to start any time measured operation in response to a user action with the remote control.

***Examiner's Response***

a) The examiner disagrees. Hesse as stated by the appellant, discloses a real time clock and a memory, which stores the times (i.e. 5pm) for user's requests to be implemented (i.e. record channel 5 at 5pm). The combination of the real time clock and the times stored in the memory performs the "timing of an interval" as explicitly claimed. Also, based upon the desired selection/reservation/recording programmed by the user which includes a user desired time, starts the timing of the interval (i.e. timer).

***Appellant's Arguments***

b) Appellant states that the examiner has admitted that Hesse does not explicitly recite the allegedly conventional return to channel instructions where upon a user action with the remote control (i.e. manual activation of a button) activates a timer to ultimately cause a return

back to a primary program after a predetermined time, and thus Hesse cannot anticipate the claims.

***Examiner's Response***

b) The examiner disagrees. Initially, the claims rejected via 35 USC 102 do not include the terms "conventional return to channel", manual operation, nor any mention of "commercials". The examiner was relaying to the appellant that given the broadest interpretation of the claimed invention (specifically claims 6, 8 and 15-18), that Hesse clearly anticipated the limitations.

***Appellant's Arguments***

c) Appellant repeats the above remarks with respect to arguments (b) above. Appellant also states that the Examiner has not presented any evidence to support the apparent conclusions to the factual inquiries that using the "manual" mode of Hesse to make it allegedly "beneficial to the user who started surfing during commercials to return to the original program when commercials are expected to be finished or before they were..." somehow suggests modifying the "auto" mode of Hesse to thereby provide all the claimed elements.

***Examiner's Response***

c) The examiner disagrees. It is noted that the examiner took "OFFICIAL NOTICE" regarding a conventional return to channel system (i.e. skip commercials) which activates a timer and returns the user back to a primary program after the user selects a scan/surf mode which is used to avoid sitting thru commercials. The examiner has incorporated Kuno (JP-10145634) which discloses the conventional capability of a user depressing a single switch on a remote, which stores a channel, activates a timer, and restores the system to the stored channel at the end

Art Unit: 2622

of a period of time (when commercials are expected to be over). For the detailed rejection see the 35 USC 103 rejection above.

The examiner stated above that Hesse allows the user to use either manual and/or the auto mode in operating the remote control. In the auto mode, Hesse clearly anticipated the limitations of the claims, which were, rejected under 35 USC 102 as stated above. The examiner relied upon Kuno to show that in the manual operation the capability of skipping commercials, storing a channel, starting a timer are conventional in the remote/TV art. Thus the examiner is not modifying the auto mode, but modifying the system of Hesse, which discloses both auto/manual mode.

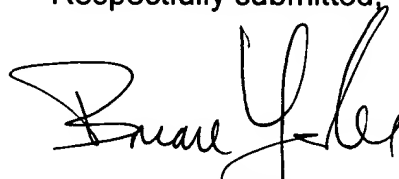
For the above reasons, it is believed that the rejections should be sustained.



BPY

June 08, 2006


Respectfully submitted,



BRIAN P. YENKE  
PRIMARY EXAMINER

Conferees:

David Ometz (SPE)



DAVID OMETZ  
SUPERVISORY PATENT EXAMINER

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